



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,745	02/11/2002	Peter G. Schultz	220032001301	2759

7590

11/18/2002

Madeline I Johnston
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304-1018

EXAMINER

BAKER, MAURIE GARCIA

ART UNIT

PAPER NUMBER

1639

DATE MAILED: 11/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DEA/FCE-1994

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/074,745	02/11/02	SCHULTZ	220032001301

EXAMINER	
Maurie Garcia Baker, Ph.D.	
ART UNIT	PAPER NUMBER
1639	6

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application
Commissioner of Patents

Please see attached Notice of Non-Responsive Amendment.

DETAILED ACTION

Please note: The number of Art Unit 1627 has been changed to 1639. Please direct all correspondence for this case to Art Unit 1639.

Notice of Non-Responsive Amendment

1. The reply filed on August 30, 2002 (Paper No. 5) is not fully responsive to the prior Office Action because of the following omission(s) or matter(s):

There is a great deal of confusion regarding the instant claims with respect to their relationship to the elected species and the election is incomplete. This is elaborated upon below. Due to these problems/omissions, it is not clear which claims should be under examination in the instant case.

The Election of Species Requirement mailed July 30, 2002 required election of species for groups (A) – (H). Applicant elected species for each group, but the election is deemed to be incomplete and confusing. First, in group (B), applicant was required to elect a Polymer array prepared. The requirement is reiterated below:

(B) Polymer array prepared (e.g. claims 95-97, 107-111, 122, 123, 125, 126, 128, 129, 145-149)

Applicant should elect, for purposes of search, a specific species of polymer array prepared by specifying its chemical composition (the election should result in a specific species of array that has all components fully (not subgenerically) defined). The number of materials in the array should also be elected.

Applicant elected “polycarbonates, at least 10 polymers”. Because this election is not entirely specific (as was required), it is impossible to determine if claims such as instant claim 95, 96, 122, 123, 125, 126, 128 or 129 read on the

elected species. Are the elected polycarbonates homopolymers, copolymers, crosslinked...? Election of a single, specific type of polymer is required.

Second, applicant states in the Response (page 4, bottom) that claims 94-103, 105-112, 115, 116, 121-149, 151, 152 and 157-161 generically read on the elected species. This is confusing because it appears that a large number of the claims indicated do not read on the elected species. Independent claims 94, 124 and 127 (and claims dependent thereon) appear to be limited to arrays of *two* polymeric materials. As applicant has elected an array of “polycarbonates, at least *10* polymers” (emphasis added), these claims do not read on the elected species. Furthermore, claims 108-110, 146-149, 157 and 159, which are stated to generically read on the elected species, in actuality also do not appear to read on the elected species.

To prevent any further confusion, applicant is requested to provide a fully responsive election and clarify the above matters. As required in the initial Office Action, a listing of all claims readable on the elected species, including any claims subsequently added should be provided.

2. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

4. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
November 18, 2002

A handwritten signature in black ink, appearing to be 'MB' with a stylized flourish.

MAURIE GARCIA BAKER, Ph.D.
PATENT EXAMINER